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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/520,264	03/07/2000	Michael C. Weaver	110172.401	1291
500 7590 07/24/2008 SEED INTELLECTUAL PROPERTY LAW GROUP PLLC 701 FIFTH AVE SUITE 5400 SEATTLE, WA 98104				
EXAMINER CHEN, TE Y				
ART UNIT 2161		PAPER NUMBER		
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/520,264

Applicant(s)

WEAVER ET AL.

Examiner

SUSAN Y. CHEN

Art Unit

2161

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 October 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 51-53, 55-78 and 80-97 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 51-53, 55-78, 80-97 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/C)
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date: _____

Response to Amendment

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on Oct. 31, 2007 has been entered.

Claims 51-53, 55-78, 80-97, are pending for examination; claims 52, 60, 64, 66-69, 71, 74-75, 77, 82-83, 85, 87-93 and 96-97 have been amended; claims 1-50, 54, and 79 have been canceled.

Specification

The specification filed on Oct. 31, 2007 to correct typographical error has been noted and kept on record.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

35 U.S.C. 101 defines four categories of inventions that Congress deemed to be the

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appropriate subject matter of a patent: processes, machines, manufactures and compositions of matter. The latter three categories define "things" or "products" while the first category defines "actions" (i.e., inventions that consist of a series of steps or acts to be performed). See 35 U.S.C. 100(b) ("The term process' means process, art, or method, and includes a new use of a known process, machine, manufacture, composition of matter, or material.").

Federal courts have held that 35 U.S.C. 101 does have certain limits. First, the phrase "anything under the sun that is made by man" is limited by the text of 35 U.S.C. 101, meaning that one may only patent something that is a machine, manufacture, composition of matter or a process. See, e.g., *Alappat*, 33 F.3d at 1542, 31 USPQ2d at 1556; *In re Warmerdam*, 33 F.3d at 1354, 31 USPQ2d at 1754, 1757 (Fed. Cir. 1994). Second, 35 U.S.C. 101 requires that the subject matter sought to be patented be a new and useful invention. Accordingly, a complete definition of the scope of 35 U.S.C. 101, reflecting Congressional intent, is that any new and useful process, machine, manufacture or composition of matter under the sun that is made by man is the proper subject matter of a patent.

The subject matter courts have found to be outside of, or exceptions to, the four statutory categories of invention is limited to abstract ideas, laws of nature and natural phenomena. While this is easily stated, determining whether an applicant is seeking to patent an abstract idea, a law of nature or a natural phenomenon has proven to be challenging. These three exclusions recognize that subject matter that is not a practical application or use of an idea, a law of nature or a natural phenomenon is not patentable. See, e.g., *Rubber-Tip Pencil Co. v. Howard*, 87 U.S. (20 Wall.) 498, 507 (1874) ("idea of itself is not patentable, but a new device by which it may be made practically useful is"); *Mackay Radio & Telegraph Co. v. Radio Corp. of America*, 306 U.S. 86, 94, 40 USPQ 199, 202 (1939) ("While a scientific truth, or the mathematical expression of it, is not patentable invention, a novel and useful structure created with the aid of knowledge of scientific truth may be."); *Warmerdam*, 33 F.3d at 1360, 31 USPQ2d at 1759 ("steps of locating' a medial axis, and creating' a bubble hierarchy . . . describe nothing more than the manipulation of basic mathematical constructs, the paradigmatic abstract idea").

The courts have also held that a claim may not preempt ideas, laws of nature or natural phenomena. The concern over preemption was expressed as early as 1852. See *Le Roy v. Tatham*, 55 U.S. 156, 175 (1852) ("A principle, in the abstract, is a fundamental truth; an original cause; a motive; these cannot be patented, as no one can claim in either of them an exclusive right."); *Funk Brothers Seed Co. v. Kalo Inoculant Co.*, 333 U.S. 127, 132, 76 USPQ 280, 282 (1948) (combination of six species of bacteria held to be nonstatutory subject matter).

Accordingly, one may not patent every "substantial practical application" of an idea, law of nature or natural phenomena because such a patent would "in practical effect be a patent on the [idea, law of nature or natural phenomena] itself." *Gottschalk v. Benson*, 409 U.S. 63, 71-72, 175 USPQ 673, 676 (1972).

Claims 75-78, are rejected under 35 U.S.C. § 101 because the claimed invention is directed to non-statutory subject matter.

As to claim 75, this claim recite subject matter "a computer readable medium" which as disclosed in instant specification may include "a separate component in the network 110" (e.g., page 10, lines 6-13), since the separate component in the network

may be software servers which broadcasting signals or carrier waves, because a carrier wave or data signal fails to fall into any one of the process, machine, manufacture, or composition of mater categories of invention under 35 U.S.C. 101, hence, it renders the claim as non-statutory *In Re Nuijten*.

As to claim 76-78, these claims have the same defects as their base claim, hence, are rejected for the same reason.

To expedite a complete examination of the instant application the claims rejected under 35 U.S.C. 101 (nonstatutory) above are further rejected as set forth below in anticipation of applicant amending these claims to place them within the four statutory categories of invention.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 51-53, 55-78, 80-97, are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As to claims 60, 69, 82 and 85, these claims recite subject matters "electronic characteristics that include metadata" which lack of explicit definition in the instant

specification, because merely disclosed the claimed subject matters by examples does not defined the metes and bounds of the claimed subject matters structure, as such, it renders the claims as indefinite.

As to claims 51-53, 55-59, 61-68, 70-78, 80-81, 83-84 and 86-97, these claims have the same defects as their base claims respectively, hence, are rejected for the same reason.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 51-53, 55-78 and 80-97 are rejected under 35 U.S.C. 103(a) as being unpatentable over Johnson et al. (U.S. Patent. No. 5,813,009), in view of Philip J. O'Shea et al. ("European Law Databases: an Experiment in Retrieval", IEEE 1997).

As to claim 60, Johnson discloses a method in a computer system [e.g. Abstract] for analyzing data produced for legal purposes comprising:

a) receiving, from an external information system that is external to the computer system, a plurality of electronic files that are stored in a data structure arranged according to a directory structure, that are subject to a legal proceeding, and that are produced by at least one party involved in the legal proceeding, said received plurality of electronic files having electronic characteristics that include metadata [e.g., col. 4, lines 45-59, the use of a Re-Indexing function that is coupled to the audit log metadata, Fig. 5];

b) storing the received electronic files in a searchable text format in a first server unit [e.g., storing Pre-Certified Data from ILM Capture to ILM database, Fig. 1C, col. 25, lines 55-67, col. 16, lines 31 – col. 17, lines 4];

c) obtaining the metadata (or index) from each of the extracted electronic files and storing the metadata in a second server unit that preserves directory structure information of the received data structures [e.g., Fig. 3 and associated texts, the Scan and Index section at col. 28, lines 49 col. 29, lines 47];

d) converting the extracted electronic files to a read-only format and storing the electronic files in the read-only format in a third server unit [e.g., col. 2, lines 2-7, col. 8, lines 30-36];

e) receiving a request for electronic files having a specified text or metadata characteristic [e.g., col. 4, lines 49 – 59, col. 11, lines 2-8, col. 29, lines 3-19];

f) processing the metadata to determine a set of electronic files having the specified text or metadata characteristic [e.g., col. 11, lines 2-49], thereby facilitating

processing of the determined set of electronic files for legal purposes [e.g., col. 7, lines [e.g., col. 21, lines 35-38, col. 18, lines 24 – col. 19., lines 9, col. 29, lines 10-46].

Johnson did not expressly disclose recursively extracting the plurality of electronic files from a plurality of paths of said directory data structure that is received from the external information system.

However, Philip J. O'Shea et al. (hereinafter referred as Philip) discloses the claimed features [e.g., the use of recursive document relevance clustering algorithm in the DAPText search/extracting system at sections: 4.4 - 4.6].

Johnson and Philip are both of the same endeavor to process network data produced for legal purposes via a directory (or index) data structure [e.g., Johnson: Abstract, lines 22-27, Fig. 8; Philip: Section: 2.1], hence, with the teachings of Johnson and Philip in front of him/her, an ordinary skilled person would have been motivated to modify Johnson's invention with the well-known technique as disclosed by Philip, because by doing so, the combined invention will be upgraded to support the document clustering and thereby facilitating the document classification.

As to claims 51-52, in addition to the features as recited in claim 60, the combined system of Johnson and Philip further discloses that the returning the indication of the determined set of electronic files includes returning a list of electronic files that contain content that matches the specified text or metadata characteristic [e.g., Johnson: col. 10, lines 12-20, col. 11, lines 27- 32].

As to claim 53, in addition to the features as recited in claims 60, the combined system of Johnson and Philip further discloses that the method of storing the metadata (or indexing) in a data base of the second server unit [e.g., Johnson: col. 13, lines 7-65].

As to claim 55, in addition to the features as recited in claim 60, the combined system of Johnson and Philip further discloses that legal proceeding is a discovery proceeding that is part of a lawsuit, a mergers, an acquisitions proceeding or a due diligence effort [e.g., Johnson: Abstract, lines 22-27, col. 26, lines 34-44; col. 27, lines 6-17].

As to claim 56, in addition to the features as recited in claim 60, the combined system of Johnson and Philip further discloses the following as claimed:

a) the electronic files produced by at least one party involved in the legal proceeding [e.g., Johnson: col. 26, line 34-44, the audit loggings, col. 26, line 65 – col. 27, line 17];

b) receiving from the information system [e.g., Johnson: the External In-Coming Information system, Fig. 1A] that is external to the computer system [e.g., Johnson: the ILM Information Filter, Fig. 1A] for analyzing data for legal purposes [e.g., Johnson: Abstract, lines 22-25], at least some electronic files [e.g., Johnson: Audit Logging, col. 26, line 64] that have been previously exchanged between the at least one party [e.g. the Off-site party, Fig. 1C] and another party prior [e.g., Johnson: the Disposal party, Fig. 1C] prior to the legal proceeding, the external information system belonging to the

at least one party of the legal proceeding [e.g., Johnson: the court of law, col. 27, line 11] and having stored therein these electronic files, [e.g., Johnson: col. 27, lines 6-17, Fig.(s) 1-Fig. 4 and associated texts].

c) wherein, the plurality of electronic files are received at the computer system during the legal proceeding, the computer system not belonging to any party of the legal proceeding [e.g., Johnson: the ILM system does not belong to the Off-site system, Fig. 1C].

As to claim 57, in addition to the features as recited in claim 60, the combined system of Johnson and Philip further discloses that the method of storing the metadata (or index) in the second server unit includes storing threading information associated with the emails [e.g., Johnson: Disposal of Records at col. 20 – 23, col. 28, lines 61-col. 29, line 19].

As to claim 58, in addition to the features as recited in claim 60, the combined system of Johnson and Philip further discloses that the method of receiving the plurality of electronic files including receiving word-processing file from the external information system [e.g., Johnson: col. 8, lines 57-59].

As to claim 59, in addition to the features as recited in claim 60, the combined system of Johnson and Philip further discloses that the method of storing the metadata (or indexing) in the second server unit includes storing metadata associated with a

native format of each of the received electronic files [e.g., Johnson: col. 10, lines 65 – col. 11, lines 8; col. 15, lines 47-50].

As to claim 61, in addition to the features as recited in claim 60, the combined system of Johnson and Philip further discloses that the recursively extracted electronic files include emails having attachments in a read-only format [e.g., Johnson: col. 7, lines 13 – 18, col. 7, lines 57 - col. 8, lines 45].

As to claim 62, in addition to the features as recited in claim 60, the combined system of Johnson and Philip further discloses that extracting a plurality of electronic files from the plurality of paths of the data structure received from the external system in response to a production request during the legal proceeding [e.g., Johnson: Abstract, the Records Administration starting at col. 31, lines 13 – col. 32, lines 29] .

As to claim 64, in addition to the features as recited in claim 60, the combined system of Johnson and Philip further discloses that providing a user interface to display and apply at least one of the annotations [e.g., Johnson: col. 19, lines 50-58] including a responsive preparation selections to the electronic files having the specified characteristic and that are responsive to the request [e.g., Johnson: col. 15, lines 9-67, col. 28, lines 31- col. 30, line 64].

As to claim 65, in addition to the features as recited in claim 60, the combined system of Johnson and Philip further discloses that the legal annotations include at least one of privileged, responsive annotations [e.g., Johnson: col. 18, line 63 - col. 19, line 6, col. 19, lines 50-58, col. 29, lines 55 – col. 30, lines 14].

As to claims 66-67, in addition to the features as recited in claim 60, the combined system of Johnson and Philip further discloses that providing a summary information [e.g., the archived catalogue, col. 18, lines 4-6] indicative of electronic files that are available to be searched and processed to determine the set of electronic files having the specified characteristic [e.g., Johnson: Fig. 4 and associated texts].

As to claim 68, in addition to the features as recited in claim 60, the combined system of Johnson and Philip further discloses that receiving a request that specifies at least one of the properties information associated with the electronic file [e.g., Johnson: the speed keys processing based on user's request, col. 19, lines 25-31].

As to claims 69-78 and 80-97, these claims recite similar limitations as claims 51-53 and 55-68, with different wording method or in form of computer product or computer system, hence, are rejected for the same reason.

Response to Arguments

Applicant's arguments based on the newly amended limitations with respect to claims 51-53, 55-78, 80-97 have been considered but are moot in view of the new ground(s) of rejection.

The examiner disagrees with applicant's arguments and piece-meal interpretations against the 35 U.S.C. 103(a) rejections.

In reply to applicant's arguments that neither Johnson nor O'Shea disclosed the claimed subject matter metadata and its usage, the examiner first points out that the claimed metes and bound of metadata structure is not defined in the instant specification as shown in the 35 U.S. C. 112 rejections addressed above, thus, it is open for reasonable art interpretations. In addition, the examiner directs applicant attention to the following figures and excerpts disclosed by Johnson:

For example, in Fig. 3 of Johnson's invention which clearly disclosed the claimed metadata processing to determine a set of electronic files having the specified text or metadata characteristic the claimed metadata (e.g., col. 18, lines 24 – col. 19, lines 9, wherein, the log file that trails in the event of any requirement for regulatory or legal compliance with discovery or other record unit requests as shown in Abstract, lines 22-27).

Furthermore, in Fig. 5 of Johnson's invention which clearly disclosed the claimed data receiving and reporting processing by the use of a Re-Indexing function that is coupled to the audit metadata kept in the log file.

Moreover, O'Shea also disclosed using metadata (e.g., the graphical structured index system, Fig. 7) to recursively process the claimed operations.

Therefore, in contrary to applicant arguments, the combined system of Johnson and O'Shea clearly represents a prima facie obvious in view of the above claimed invention.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

Berson (U.S. Patent No. 6,532,459) which disclosed a system with methods to find, identify, tracking, and correct personal information in diverse databases.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to SUSAN Y. CHEN whose telephone number is (571)272-4016. The examiner can normally be reached on Monday - Friday from 7:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mofiz Apu can be reached on 571-272-4080. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Susan Y Chen/
Partial Sig. Examiner
Art Unit 2161

July 18, 2008